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09/773,682	01/31/2001	Jeremy Burr	INTL-0456-US (P9810)	8497

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EXAMINER
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TRAN, PHILIP B

ART UNIT	PAPER NUMBER
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2155

DATE MAILED: 05/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/773,682

Applicant(s)

BURR, JEREMY

Examiner

Philip B Tran

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 13 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 13, lines 2-3, the limitation "...communications **between** a first terminal ..." is incomplete because a second object is missing which makes the claim to be indefinite.

Regarding claim 24, lines 2-3, the limitation "...communications **between** a first terminal ..." is incomplete because a second object is missing which makes the claim to be indefinite.

### *Claim Rejections - 35 U.S.C. § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-30 are rejected under 35 U.S.C. § 102(e) as being anticipated by Gudjonsson et al (Hereafter, Gudjonsson), U.S. Pat. No. 6,564,261.

Regarding claim 1, Gudjonsson teaches a method comprising :

enabling communications between a first terminal and selected second terminals (= enabling communication services between users (7) of clients (11)) [see Figs. 1 & 2 and Abstract and Col. 8, Lines 6-46];

enabling the storage of a modifiable list of second terminals (= contact list or buddy list) [see Col. 35, Lines 38-44] that the first terminal is able to communicate with (= database (13) contains the contact list for each user) [see Col. 28, Lines 34-46]; and

enabling the ability to modify said list to be restricted (= adding or removing users to/from the contact list with authentication) [see Col. 27, Lines 5-16 and Col. 27, Lines 36-44 and Col. 31, Lines 43-59].

Regarding claim 2, Gudjonsson further teaches the method of claim 1 including communicating between a first terminal and a base station and forwarding communications from said first terminal (= user (7) of client (11)) [see Figs. 1 & 2 and Abstract and Col. 8, Lines 6-46] to said base station (= cluster) [see Figs. 1 & 13] on to said second terminals (= other users (7) of clients (11)) (= communication between users and the cluster (= a collection of servers and database)) [see Figs. 1 & 13].

Regarding claim 3, Gudjonsson further teaches the method of claim 1 including enabling communications between a first terminal that is a handheld unit (= mobile

phone or PDA) [see Col. 8, Lines 18-20] and said base station (= cluster) [see Figs. 1 & 13] using a wireless communication protocol (= Wireless Application Protocol (WAP)) [see Col. 7, Lines 35-60].

Regarding claim 4, Gudjonsson further teaches the method of claim 3 including communicating between said base station and said second terminals at least in part over the Internet (= the cluster (= a collection of servers and database) communicates with other entities such as clients, other clusters and/or Internet) [see Fig. 13 and Col. 4, Lines 56-60].

Regarding claim 5, Gudjonsson further teaches the method of claim 4 including exchanging text messages between said first terminal and selected second terminals (= real-time text chat session between the users) [see Col. 13, Lines 10-19].

Regarding claim 6, Gudjonsson further teaches the method of claim 1 including communicating between said first terminal and said selected second terminals through a chat server (= establishing a communication session such as voice chat or text chat between users using one or more cluster network (= a collection of servers and database)) [see Col. 3, Lines 46-63 and Col. 24, Lines 32-39].

Regarding claim 7, Gudjonsson further teaches the method of claim 6 including storing said modifiable list of second terminals in said base station (= database (13) contains the contact list for each user) [see Col. 28, Lines 34-46].

Regarding claim 8, Gudjonsson further teaches the method of claim 7 including blocking communications, from said handheld unit, received by said base station and preventing those communications from proceeding to a second terminal not listed in said modifiable list (= connections between services and/or users are going through a special inter-cluster service which can limit what services are actually available [see Col. 8, Lines 29-32] and communications between users are initiated by the invitation wherein the routing service can ignore the invitation [see Col. 9, Lines 8-40] and the service management server keep a list of users that may enter the conference [see Col. 28, Lines 3-6]. Therefore, communications between the first terminal and the second terminal are not directly but being controlled and blocked by the inter-cluster-service of the cluster (= base station)).

Regarding claim 9, Gudjonsson further teaches the method of claim 1 wherein enabling the ability to modify said list to be restricted includes enabling a requirement for a password to obtain access to said list (= authenticating and accessing contact list with a password) [see Col. 11, Lines 35-64 and Col. 27, Lines 5-16].

Regarding claim 10, Gudjonsson further teaches the method of claim 1 including requiring a password to initiate an outgoing transmission from said first terminal (= authentication with user identity and password) [see Col. 11, Lines 35-43 and Col. 31, Lines 43-59].

Regarding claim 11, Gudjonsson teaches an article comprising a medium storing instructions that enable a processor-based system to:

enable communications between a first terminal and selected second terminals (= enabling communication services between users (7) of clients (11)) [see Figs. 1 & 2 and Abstract and Col. 8, Lines 6-46];

enabling the storage of a modifiable list of second terminals (= contact list or buddy list) [see Col. 35, Lines 38-44] that the first terminal is able to communicate with (= database (13) contains the contact list for each user) [see Col. 28, Lines 34-46]; and

enable restrictions on the ability to modify said list (= adding or removing users to/from the contact list with authentication) [see Col. 27, Lines 5-16 and Col. 27, Lines 36-44 and Col. 31, Lines 43-59].

Regarding claim 12, Gudjonsson further teaches the article of claim 11 further storing instructions that enable the processor-based system (= cluster) [see Figs. 1 & 13] to communicate with a first terminal and forward communications from said first terminal (= user (7) of client (11)) [see Figs. 1 & 2 and Abstract and Col. 8, Lines 6-46]

to said second terminal (= other users (7) of clients (11)) (= communication between users and the cluster (= a collection of servers and database)) [see Figs. 1 & 13].

Regarding claim 13, Gudjonsson further teaches the article of claim 11 further storing instructions that enable communications between a first terminal that is a handheld unit (= mobile phone or PDA) [see Col. 8, Lines 18-20] using a wireless communication protocol (= Wireless Application Protocol (WAP)) [see Col. 7, Lines 35-60].

Regarding claim 14, Gudjonsson further teaches the article of claim 13 further storing instructions that enable the processor-based system to communicate with said second terminals at least in part over the Internet (= the cluster (= a collection of servers and database) communicates with other entities such as clients, other clusters and/or Internet) [see Fig. 13 and Col. 4, Lines 56-60].

Regarding claim 15, Gudjonsson further teaches the article of claim 14 further storing instructions that enable the processor-based system to exchange text messages between a first terminal and selected second terminals (= real-time text chat session between the users) [see Col. 13, Lines 10-19].

Regarding claim 16, Gudjonsson further teaches the article of claim 11 further storing instructions that enable the processor-based system to communicate between



said first terminal and said selected second terminals through a chat server (= establishing a communication session such as voice chat or text chat between users using one or more cluster network (= a collection of servers and database)) [see Col. 3, Lines 46-63 and Col. 24, Lines 32-39].

Regarding claim 17, Gudjonsson further teaches the article of claim 16 further storing instructions that enable the processor-based system to store said modifiable list of second terminals (= database (13) contains the contact list for each user) [see Col. 28, Lines 34-46].

Regarding claim 18, Gudjonsson further teaches the article of claim 17 further storing instructions that enable the processor-based system to block communications from said handheld unit and prevent those communications from proceeding to a second terminal not listed in said modifiable list (= connections between services and/or users are going through a special inter-cluster service which can limit what services are actually available [see Col. 8, Lines 29-32] and communications between users are initiated by the invitation wherein the routing service can ignore the invitation [see Col. 9, Lines 8-40] and the service management server keep a list of users that may enter the conference [see Col. 28, Lines 3-6]. Therefore, communications between the first terminal and the second terminal are not directly but being controlled and blocked by the inter-cluster-service of the cluster (= base station)).

Regarding claim 19, Gudjonsson further teaches the article of claim 11 further storing instructions that enable the processor-based system to enable a requirement for a password to obtain access to said list (= authenticating and accessing contact list with a password) [see Col. 11, Lines 35-64 and Col. 27, Lines 5-16].

Regarding claim 20, Gudjonsson further teaches the article of claim 11 further storing instructions that enable the processor-based system to require a password to initiate an outgoing transmission from said first terminal (= authentication with user identity and password) [see Col. 11, Lines 35-43 and Col. 31, Lines 43-59].

Regarding claim 21, Gudjonsson teaches a system comprising :  
a processor-based device (= the cluster or a collection of servers and database)  
[see Figs. 1 & 13]; and

a storage (= database (13)) [see Fig.s. 1 & 13] coupled to said processor-based device storing instructions that enable communications between a first terminal and selected second terminals (= enabling communication services between users (7) of clients (11)) [see Figs. 1 & 2 and Abstract and Col. 8, Lines 6-46], enable the storage of a modifiable list of second terminals (= contact list or buddy list) [see Col. 35, Lines 38-44] that the first terminal is able to communicate with (= database (13) contains the contact list for each user) [see Col. 28, Lines 34-46] and enable restrictions on the ability to modify said list (= adding or removing users to/from the contact list with

authentication) [see Col. 27, Lines 5-16 and Col. 27, Lines 36-44 and Col. 31, Lines 43-59].

Regarding claim 22, Gudjonsson further teaches the system of claim 21 including a wireless interface (= Wireless Application Protocol (WAP) [see Col. 7, Lines 35-60]. Since wireless application protocol is using, a wireless interface is implemented [see Figs. 1 & 13]).

Regarding claim 23, Gudjonsson further teaches the system of claim 21 wherein said storage stores instructions that enable said device to communicate with a first terminal (= user (7) of client (11)) [see Figs. 1 & 2 and Abstract and Col. 8, Lines 6-46] and forward communications from said first terminal to said second terminal (= other users (7) of clients (11)) (= communication between users and the cluster (= a collection of servers and database)) [see Figs. 1 & 13].

Regarding claim 24, Gudjonsson further teaches the system of claim 21 wherein said storage stores instructions that enable communications between a first terminal that is a handheld unit (= mobile phone or PDA) [see Col. 8, Lines 18-20] using a wireless communication protocol (= Wireless Application Protocol (WAP)) [see Col. 7, Lines 35-60].

Regarding claim 25, Gudjonsson further teaches the article of claim 24 wherein said storage stores instructions that enable the processor-based device to communicate with said second terminals at least in part over the Internet (= the cluster (= a collection of servers and database) communicates with other entities such as clients, other clusters and/or Internet) [see Fig. 13 and Col. 4, Lines 56-60].

Regarding claim 26, Gudjonsson further teaches the system of claim 25 wherein said storage stores instructions that enable the processor-based system to exchange text messages between a first terminal and selected second terminals (= real-time text chat session between the users) [see Col. 13, Lines 10-19].

Regarding claim 27, Gudjonsson further teaches the system of claim 21 wherein said storage stores instructions that enable the device to communicate between said first terminal and selected second terminals through a chat server (= establishing a communication session such as voice chat or text chat between users using one or more cluster network (= a collection of servers and database)) [see Col. 3, Lines 46-63 and Col. 24, Lines 32-39].

Regarding claim 28, Gudjonsson further teaches the system of claim 27 wherein said storage stores instructions that enable the device to store said modifiable list of second terminals (= database (13) contains the contact list for each user) [see Col. 28, Lines 34-46].

Regarding claim 29, Gudjonsson further teaches the system of claim 28 wherein said storage stores instructions that enable the device to block communications from said handheld unit and prevent those communications from proceeding to a second terminal not listed in said modifiable list (= connections between services and/or users are going through a special inter-cluster service which can limit what services are actually available [see Col. 8, Lines 29-32] and communications between users are initiated by the invitation wherein the routing service can ignore the invitation [see Col. 9, Lines 8-40] and the service management server keep a list of users that may enter the conference [see Col. 28, Lines 3-6]. Therefore, communications between the first terminal and the second terminal are not directly but being controlled and blocked by the inter-cluster-service of the cluster (= base station)).

Regarding claim 30, Gudjonsson further teaches the system of claim 21 wherein said storage stores instructions that enable the device to require a password to obtain access to said list (= authenticating and accessing contact list with a password) [see Col. 11, Lines 35-64 and Col. 27, Lines 5-16].

#### ***Other References Cited***

5. The following references cited by the examiner but not relied upon are considered pertinent to applicant's disclosure.

A) Aggarwal et al, U.S. Pat. No. 6,260,148, discloses massaging forwarding and property notifications with contact list.

B) Greene, U.S. Pat. No. 6,668,173, discloses instant message user location tracking system.

C) Schwartz et al, U.S. Pat. No. 6,473,609, discloses wireless devices communicating with server via a base station.

D) Hoo, U.S. Pat. No. 5,794,149, discloses base station controlled handoff system with a list of base stations.

E) Daly et al, U.S. Pat. No. 6,393,014, discloses wireless devices communicating with a server via a base station.

F) Williamson et al, U.S. Pat. No. 5,953,320, discloses wireless communication device receiving a neighbor list message from a base station.

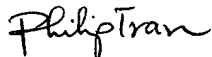
G) Lincke, U.S. Pat. Application No. US 2001/0044310, discloses user-specific location information.

6. A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS ACTION IS SET TO EXPIRE THREE MONTHS, OR THIRTY DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION. FAILURE TO RESPOND WITHIN THE PERIOD FOR RESPONSE WILL CAUSE THE APPLICATION TO BECOME ABANDONED (35 U.S.C. § 133). EXTENSIONS OF TIME MAY BE OBTAINED UNDER THE PROVISIONS OF 37 CAR 1.136(A).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Tran whose telephone number is (703) 308-8767. The Group fax phone number is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T. Alam, can be reached on (703) 308-6662.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

  
Philip B. Tran  
Art Unit 2155  
May 14, 2004